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IN THE

Supreme Court of the United States

OCTOBER TERM, 1944.

No. 656.

SINCLAIR & CARROLL COMPANY, INC.,
Petitioner,

v.

INTERCHEMICAL CORPORATION,
Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF FOR PETITIONER.

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THE COURT PRESS, N. Y. C.

INDEX.

	PAGE
Opinions Below	1
Jurisdiction	1
Questions Presented	2
The Statute Involved	2
Statement	3
The Patent	3
The Fast Rotary Press	7
Gessler's Contribution	8
Prior Patents and Publications	12
Commercial Success and Long Felt Want	15
Infringement	19
Specification of Errors	24
Summary of Argument	25
Argument	26
I. The patent is void for want of invention. It discloses only the application of ordinary skill in the art	26
II. Infringement	32
III. The findings of the District Court were not clearly erroneous	35

Table of Cases Cited:

Adamson v. Gilliland, 242 U. S. 350, 353 35
Altoona Publix Theatres Inc. v. American Tri-Ergon Corp., et al., 294 U. S. 477, 486, 488 ..... 26, 30
Atlantic Works v. Brady, 107 U. S. 192, 200 26
Concrete Appliances Co. v. Gomery, 269 U. S. 177, 180 ..... 26, 27
Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84, 90, 91, 94 (1941) 26, 32

PAGE

Davis v. Schwartz, 155 U. S. 631 35

Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126, 136 35

Firestone Tire & Rubber Co. v. United States Rubber Co., 79 F. (2d) 948, 954 31

Farrer v. Ferris, 145 U. S. 132 35

Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U. S. 275 36

Hotchkiss v. Greenwood, 11 How. 264, 267 26

Kimberly v. Arms, 129 U. S. 512, 524 35

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U. S. 464, 476 ..... 29, 30

Silver King Coalition Mines Co. v. Silver King Consol. Mining Co., 204 Fed. 166 35

Tilghman v. Proctor, 125 U. S. 136, 149 35

Toledo Pressed Steel Co. v. Standard Parts, Inc., 307 U. S. 350, 356 29

United Carbon Co. et al. v. Binney & Smith Co., 317 U. S. 228, 236 35

Warren v. Keep, 155 U. S. 265 35

OTHER AUTHORITIES CITED:

Federal Rules of Civil Procedure, Rule 52(a) 35

Judicial Code, as amended by the Act of February 13, 1925 (U. S. C., Title 28, Sec. 347), Section 240(a) 2

35 U. S. C., Sec. 33 (R. S. Sec. 4888; Mar. 3, 1915, c. 94, Sec. 1, 38 Stat. 958) 2, 3, 7, 25, 26, 35

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Opinions Below.

The opinion of the District Court (II, 1024*) is reported in 50 F. Supp. 881. The opinion of the Circuit Court of Appeals (II, 1094) is reported in 144 F. (2d) 842.

Jurisdiction.

The judgment of the Circuit Court of Appeals was entered August 28, 1944 (II, 1094). Petition for rehearing was denied September 22, 1944 (II, 1118). Petition for certiorari was filed November 6, 1944, and granted December 11, 1944. Jurisdiction rests

* Roman numerals in parentheses indicate record volume.

on Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (U. S. C., Title 28, Sec. 347).

Questions Presented.

This is a patent infringement action. The petitioner here was defendant in the District Court. The District Court held the patent void for want of invention and because anticipated by prior patents, and also held that there was no infringement. The Circuit Court of Appeals reversed these findings and held the patent valid and infringed.

Petitioner contends:

(1) That nothing done by the patentee required more than ordinary skill in the art;

(2) That the petitioner's ink does not infringe because not within the scope of the patent claims unless those claims are construed more broadly than allowed by R. S. 4888, and

(3) That the findings of the District Court were not "clearly erroneous" and should not have been set aside.

The Statute Involved.

35 U. S. C., Sec. 33. *Application for patent; description; specification and claim.* Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compound-

ing, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. (R. S. Sec. 4888; Mar. 3, 1915, c. 94, Sec. 1, 38 Stat. 958.)

Statement.

The Patent.

The patent, No. 2,087,190 (II, 733) is for a printing ink. It was issued to Albert E. Gessler July 13, 1937, on an application filed July 14, 1932, forfeited April 10, 1936, renewed April 11, 1936, and assigned to respondent's predecessor. Claims 3, 10, 11, 12 and 13 are in suit. Claim 3, which is typical and here used as the basis for discussion, is as follows:

> A printing ink which is substantially non-drying at ordinary temperatures and dries instantly on heating of the printed matter, consisting of coloring matter dispersed in an organic viscous vehicle consisting of a liquid component and a solid component completely dissolved in the liquid component in sufficient quantity to give the ink the consistency of an ordinary oil-varnish printing ink—the solid component being a member of the group consisting of natural and synthetic resins and cellulose compounds, substantially all of the

liquid component having a vapor pressure at 20° C. as low as that of diethylene glycol monobutyl ether at 20° C., and the major part of the liquid component having a vapor pressure which at 150° C. approximates that of ethyl alcohol at ordinary temperatures and forming a stable solution with the solid component.

Claim 3 needs translation. The term "ordinary temperatures" appears in line two. In the record the witnesses sometimes substitute the phrase "room temperature". The claim and the witnesses mean a temperature of about 20° Centigrade (68° Fahrenheit). That is why 20° C. is used in the claim.

Vapor pressure is used to indicate volatility or rate of evaporation. When a liquid evaporates, molecules of vapor are emitted which create a pressure against the surrounding atmosphere. The application of heat increases the rate of evaporation, and the more rapid the evaporation, the greater is the vapor pressure. That pressure is measured and expressed in terms of the height of a column of mercury which the pressure would support, just as atmospheric pressure is indicated. In the patent the height of the mercury column is stated in millimeters.

The short or trade name for the diethylene glycol monobutyl ether, mentioned in the claim, is "butyl carbitol" (I, 28). It has a vapor pressure at 20° C. (ordinary temperature, 68° F.) of only .02 millimeters of mercury, and a vapor pressure of 50 mm. at 150° C. The ethyl alcohol mentioned in the claim has a vapor pressure at ordinary temperatures of 40 mm. (II, 733a.-Col. 1, l. 53—Col. 2, l. 2.)

The claim is the same as if it read:

"substantially all of the liquid component having a vapor pressure at ordinary room temperature

(20° C.) as low as .02 millimeters, and the major part of the liquid component having a vapor pressure which at 150° C. approximates 40 mm."

This shows that the solvent in the patented ink, at room temperatures, has a slow evaporation rate and remains wet on the type, but becomes highly volatile when heated to 150° C.

The patent is not for a process or method of using ink, but merely for a compound—a composition of matter.

The ink is a "heat-set" ink, one whose liquid component or solvent does not evaporate or dry at room temperature, hence causes the ink to stay moist on the type and inking rollers, but which will evaporate instantly on application of heat to the printed paper. The use of the ink requires a heating device on the press. The ink is of special utility on modern high speed rotary presses for printing on glossy, non-absorbent paper; provided the press is equipped with a heating device, as it makes possible the immediate printing of the reverse side and the folding of the pages, without smudging the ink.

The patentee did not initiate the idea of using a heating device. That was suggested to him by another. Neither did he discover or invent an ink solvent which stays wet at room temperature and dries instantly on application of heat. Such solvents were on the market, and their characteristics advertised. When requested by an ink maker to furnish such a "heat-set" ink for use on a press to be equipped with a heater, he merely used a suitable solvent, made and advertised by chemical manufacturers, to compound his ink.

Respondent's position is that Gessler's invention consisted in "discovering and disclosing *how to select*" the solvent (Respondent's Brief in Opposition to Certiorari, p. 12).

Petitioner contends that the conception that a "heat-set" ink could be made by use of a known solvent, known to have a low evaporation rate at ordinary temperature, and a high evaporation rate at high temperatures, and the selection of such a solvent from the catalog of a chemical manufacturer, was not invention or anything more than ordinary skill in the art; and that this is particularly true in view of the fact that prior patents and publications taught the making of inks with solvents non-volatile at ordinary temperature and highly volatile on heating.

Petitioner also contends that the patent is not infringed. The patent states that the solvent in the claimed ink must be non-volatile at ordinary temperature, but at 150° C. must have a vapor pressure (evaporation rate) which "approximates" 40 mm. (that of ethyl alcohol at ordinary temperature).

The solvent in petitioner's ink is not volatile at ordinary temperature, but at 150° C. its vapor pressure (evaporation rate) is only 20 mm. (about that of water and only one-half that of ethyl alcohol at ordinary temperature).

The precise question is whether 20 mm. "approximates" 40 mm. Respondent asserts it does. Petitioner contends that it does not. Petitioner's position is that Gessler himself, when drafting the claim, did not have in mind a solvent of such a low vapor pressure as 20 mm. at 150° C.; that Gessler did not then know of any form of heating device with which such a solvent could be used, and that to construe the claim to include the petitioner's ink would depart

from R. S. 4888, requiring the patentee to describe his invention in "clear, concise, and exact terms", and "particularly point out and distinctly claim" it.

Petitioner also contends that the findings of the District Court were amply supported by the evidence, and that in overturning them the Court below departed from the rule that such findings may not be set aside unless clearly erroneous.

The Fast Rotary Press.

The modern high-speed rotary printing press into which is fed a continuous "web" or strip of paper, which is printed by contact with rapidly revolving printing cylinders, is and has been for many years in common use (I, 148, 605). Ink used in such presses, as with other presses, must be of a kind which stays moist indefinitely at room temperatures and does not dry on the inking rollers and type (I, 704). When printed on absorbent paper, such as newsprint, it is not necessary that the ink dry quickly after printing or that any heater for that purpose be attached to the press. The paper absorbs the ink, and after the paper is printed on one side, it may pass immediately over other rollers and be printed on the other side, and then pass immediately to cutting and folding devices, all without smearing or smudging (I, 587, 601). Printing on non-absorbent or glossy paper, generally used in magazines, presents a different problem. When printed on one side of the paper, the ink is not absorbed, and if it remains wet, it is easily smudged or rubbed off. Printing on the other side must be delayed until the ink on the one side is dried (I, 592). An ink which dries quickly at room temperatures cannot

be used, as it dries equally quickly on the rollers and type (I, 704). Prior to 1932, printing of magazines on glossy or non-absorbent papers was not generally done on the high speed presses such as are used for newspapers. Usually sheets, not continuous strips, were pressed on flat plates, and after printing one side, were laid aside for a time until dry and then printed on the other side, and after that the cutting and folding were further delayed (I, 587, 588, 592, 600). If rotary presses were used with smooth paper, there was a delay after printing one side, to permit drying, and another delay before folding (I, 149-50, 611-13).

Solvents for use in inks, and which would stay wet on the rollers and type but would dry instantly on application of heat had long been available, and inks containing such solvents had been known and made (I, 251-2, 261-6, 283-8, 320-2, 414-19, 690; II, 957, 961, 983, 985), but no one seems to have provided the fast rotary presses with heating devices to dry the ink instantly after printing so as to permit use of such presses on non-absorbent paper (I, 73, 74, 153-4, 190, 195, 513, 551, 588-9, 605-6).

Gessler's Contribution.

In 1930 Gessler, a chemist, was employed by Zinsser & Co., makers of chemicals, pigments and dyes (I, 109). Frank W. Cray was in the printing ink business with Cray-Finne Corporation, with which Gessler's company did business (I, 65, 72). In June, 1930, Cray asked Gessler to prepare an *odorless* printing ink, and Gessler prepared some samples (I, 72, 109, 702). In this work, Gessler wanted an odorless solvent which would stay wet at ordinary

temperatures. To find it, he examined the catalogues (II, 985-8; III, Ex. U-2) of Carbide and Carbon Chemicals Corporation, a manufacturer of chemical products, and found advertised there three solvents which seemed suitable for the ink, which he tried out. He discarded two and finally selected butyl carbitol (I, 719-722). The catalogue of January 1, 1929 (II, 987-8), described butyl carbitol. Gessler observed from the catalogue that butyl carbitol has a mild odor, and that it has a vapor pressure of only .05 mm. at 20° C., and a boiling point of 222° C., and therefore would not dry at room temperature. He selected it as a solvent for an odorless ink which would stay wet on the rollers and type and not harden on the press. This odorless ink was unsatisfactory because it stayed wet too long on the paper (I, 72-3). At that time (1930), although Gessler noticed that butyl carbitol is highly volatile on application of heat, and the catalogue indicated that characteristic (I, 720), he was not then interested in whether the ink would dry on application of heat, and no suggestion for putting a heating device on a press was made. However, late in 1931 Cray thought of heat for drying the ink after printing on a fast press and again went to Gessler. Cray testified (I, 73):

> "So I got hold of Dr. Gessler, and I discussed that point with him. I said, 'Could you make me an ink that would be dry after being printed? *We can put it over some kind of a heating device.*' He said, 'Yes, I think we could.' He said, 'In fact, one of those inks I made for you in the beginning would do that.'" (Italics ours.)

It was as easy as that. The old samples of the odorless ink made in 1930 were found to have dried.

so in February, 1932, Gessler made up new samples, and as Cray said, "I was able to make a print of that and pass that print over a hot plate and dry the ink. From there on we went to work" (I, 74).

Of this incident Gessler said:

> "Q. Did Mr. Cray ask you to furnish him an ink which could be used on a press provided with a heater? A. Yes, he did" (I, 706).

Again:

> "And now, when Mr. Cray came, in the year 1932, and told me that heating units, steam-heated rollers are used on printing presses, that was the last key that I needed for the solution of the problem. I had not known that before, and I knew that if I could apply any heat to the thin film of those inks that they would dry almost instantaneously" (I, 708-9).

Cray had not said that heated rollers were in use, but that they could be supplied. For test purposes he converted some cooling drums into heaters, by substituting steam for the cooling brine (I, 74).

The record shows that it was Cray, not Gessler, who thought of using heating devices on the press, and that solvents for ink, with the required characteristics, were well known, made by others, not Gessler.

The patent, of course, is for a printing ink, and not for a method or process, or for the use of a heater. In April, 1935, Gessler filed an application for a method patent, covering the combined use of a heat set ink and a heating device (II, 733a, col. 2, ll. 28-32). He later abandoned that application (I, 129-30). The use of a heater was conceived by Cray,

not Gessler, and Gessler could not properly claim to be the inventor of that method (I, 73, 97, 708-9).

The claims in suit cover every ink containing a solvent having the specified vapor pressures at ordinary temperature (20° C.) and at elevated temperature (150° C.), *regardless of why it is put in the ink.*

Gessler was not a mechanic: he was a chemist. The suggestion for a heating device, which Gessler himself said was the "key" to the problem, coming from Cray, left to Gessler only the task of selecting a solvent, non-volatile at room temperature, but highly volatile at elevated temperatures. He did not discover or make the solvent: It was ready to his hand. Indeed, when the problem of compounding a heat set ink was presented to him, the solution was instantaneous and required no reflection. He had already made such an ink in 1930 as an odorless ink, and at least one suitable solvent had been on the market to his own knowledge for at least three years.

It is this "selection" of a solvent which respondent claims to be invention. In its brief in opposition to certiorari respondent said:

> "Gessler discovered and disclosed that it *is* possible to produce the desired ink by selection from known solvents" (p. 4).

Also, that his accomplishment was

> "discovering and disclosing *how to select* the principal ingredient of the compound" (p. 12).

Prior Patents and Publications

Patent No. 1,439,696, issued to Doughty in 1922 (II, 961), covered a composition of ink. The inventor had in mind particularly an ink with metallic pigments suitable for stamping titles and designs on bookbindings, but also "for other purposes to which the ink may be adapted" (II, 961, ll. 12-17). He stated:

> "A difficulty which has prevented the use of metallic pigment inks is due to vehicles which dry too rapidly on the inking rolls, covering them generally with a gummy coating which prevents transfer of the ink to the type or die. In avoiding this extreme it is necessary to provide an ink which when once applied will dry rapidly.
>
> It is the object of the invention, therefore, to provide an ink and an ink vehicle having the necessary properties, among others comparative slowness in drying without a tendency to become gummy, a consistency permitting transference of the ink through inking rolls to the type or die, rapid drying when applied to the work, and ability to protect the pigment from oxidation and consequent discoloration.
>
> I have discovered that these desirable properties may be imparted to the ink by the use of a suitable medium in the vehicle for the pigment and that such a medium will, moreover, permit rapid drying of the ink by the application of heat to the type or die" (II, 961, ll. 38-61).

Doughty stated that the medium (solvent) should be "capable of being vaporized * * * but its boiling point should be relatively high to reduce vaporization at atmospheric temperatures, and consequently to prevent rapid drying on the inking rolls" and that

"Solvents boiling materially below 200° C. are unsuitable because the ink dries too rapidly on the rolls" (II, 961, ll. 62-74).

Among suitable solvents Doughty named terpinyl acetate (II, 961, l. 90). It has the same vapor pressure as butyl carbitol (the solvent around which Gessler's claims are built), viz., about .02 mm. at ordinary temperature, and about 60 mm. at 150° C., and has a boiling point of about 222° C. (I, 306-8; II, 1099; III, Exs. D-1, E-1, J).

Doughty's idea of a heating device to dry the ink after printing was to heat the type or die itself and apply heat that way. He stated:

> "The ink dries very slowly at atmospheric temperature owing to the high boiling point of the volatile solvent. It dries rapidly, however, when applied with a heated die" (II, 962, ll. 58-61).

His specifications teach unmistakably that a composition of ink which is not volatile at room temperatures, and hence non-drying on the inking rolls or type, but which will dry quickly by application of heat after printing, may be made by the use of a solvent, non-volatile at room temperature, but with a boiling point between 200° C. and 300° C. If Doughty's patent had been later than Gessler's, this ink disclosed by Doughty would clearly infringe Gessler's claims.

The patent to Lefferts and Stevens, No. 380,654, issued in 1888 (II, 957), covers a composition of ink. Lefferts' specifications teach the use of heat after printing for drying, and solvents which keep the ink from drying before printing (II, 958, ll. 62-68, 75-80, 109-114). True, the primary purpose

was to produce an ink with a solvent which would dissolve celluloid (pyroxylin) surfaces on which printing is done, and cause the ink to penetrate and thus adhere to the printed surface, just as butyl carbitol is a celluloid (pyroxylin) solvent (II, 987). The patent recommends oil of cassia as a solvent for an ink and claims 3 and 5 cover that ink (II, 958, ll. 33-44, 103; 959, ll. 6, 108, 118). The oil of cassia available today has a vapor pressure as low as .02 mm. at 20° C. and of 40 mm. at 150° C. Hence Lefferts' oil of cassia ink comes squarely within the terms of Gessler's claims and if made today would infringe Gessler's patent (I, 280-2, 321-2; III, Exs. P, Q). The Court of Appeals brushed this patent aside, stating there was no proof that the oil of cassia of 1888 had the same characteristics as oil of cassia of 1942, although one witness said it is the natural essence of a plant, and is accepted as being the same (I, 332, 336).

The patent to Jirousek, No. 1,954,627, applied for April 18, 1932 (II, 983) was rejected by the Court of Appeals as not being a proper reference against Gessler, because, although Jirousek described heat-set ink, the ink also contains some linseed oil, which Gessler excludes. But Jirousek's specifications are pertinent as bearing on the question whether Gessler did more than exercise ordinary skill. Jirousek's patent discloses ink containing solvent mixtures which remain wet at normal temperatures, which have high boiling points, and which dry quickly on application of heat (II, 983, ll. 71-78, 97-103; 984, ll. 8-15; I, 313-6, 414-19, 427-9, 468).

The article by M. E. Hanson, published in Printing Equipment Engineer in December, 1931 (II, 990), was discarded by the Court of Appeals as merely

stating the problem without giving a solution. In Hanson's statement of the characteristics desired for a plastic ink "for rapid drying", he included the requirements that the ink would not dry on the rolls at room temperature, but would "dry in a small fraction of a second" on application of heat to the printed sheet. He did more than merely state the problem. He pointed out that the solution of the problem lay in the use of solvents having evaporation characteristics such that, at room temperature, the ink does not dry, but dries instantly on application of the highest heat that can be practically applied to the printed paper. Hanson's article was really a suggestion that chemical manufacturers conduct further research to produce the desired solvents. He evidently had not examined the 1929 and 1930 catalogues of Carbide and Carbon Chemicals Corporation (II, 985-8; III, Ex. U-2) which revealed such a solvent.

With Hanson's article and some of the prior patents before him, the Carbide and Carbon Chemicals Corporation's catalogue in his hand, and in his mind Cray's great news that a heating device could be attached to a fast press, did a chemist need to exercise more than ordinary skill in the art of chemistry to "select" a solvent and prepare the desired composition of ink?

Commercial Success and Long Felt Want.

The discussion on pages 29-31 of this brief about the bearing of these factors on the issue of invention indicates that commercial success has little importance on the question whether the improvement resulted from ordinary skill, and that the importance of a "long felt want" depends on whether the "want" was

articulate and resulted in attempts to solve it, which had failed.

The record shows that the commercial success of Cray's conception of combining a heating device on a rotary press with the use of heat-set ink has been great. Many of the magazines having a large circulation are now printed in that manner (I, 153-6, 236-7, 587-8, 623, 632) with great saving in time and labor and with other advantages (I, 154, 588, 596, 598, 613, 624).

This has all developed since 1932 (I, 83, 84, 88, 101, 128, 129, 153, 187, 191, 586). Since that time, and while Gessler's application was still pending, many makers of printing ink developed "heat-set" inks containing petroleum solvents (I, 82-5, 129, 506, 586, 603, 641). Doubtless what Cray was doing with heaters and test runs in printing houses was noised about, and stirred the ink makers to action.

In the meantime, Gessler's butyl carbitol was soon found to damage glycerine-glue inking rollers, and could only be used on rollers of rubber or other material (I, 91-2, 120-5; II, 766-7). Furthermore, butyl carbitol ink is *eight times* more expensive than the petroleum solvent ink (I, 86). Such a cost is important to printers using hundreds of tons of ink in a year (I, 101-2, 227, 570). Since 1936 butyl carbitol inks have been used only in small quantities, by Kalamazoo Vegetable Parchment Company (less than 1% of its ink requirements), whose business requires an odorless ink and which is willing to pay a high price for it (I, 200-3, 226; II, 955).

The respondent's predecessor first used butyl carbitol. In 1934 it changed to butyl carbitol *acetate*, which does not damage glue-glycerine rollers, and in 1935 changed to petroleum solvents (I, 89, 91, 124, 129,

134; II, 950-2). The heat-set inks made by the Levey Company seem to have contained petroleum solvents during and since 1933 (I, 84, 88, 102, 129).

Petroleum solvents having much lower vapor pressure at 150° C. than 40 mm. have been the successful solvents (I, 88-9, 102, 127-9, 631, 641, 672; III, Exs. B-1, R-2). The accused ink of the petitioner contains a petroleum solvent referred to in the record as "502-C oil" and having a vapor pressure of only 20 mm. at 150° C. (I, 50, 56, 240, 281, 306; II, 741; III, Exs. O, P, Q). These petroleum solvent inks with lower volatility than butyl carbitol ink have required flame heaters instead of steam heated drums to dry them (I, 68, 70, 92-3, 128, 550-1, 158, 505, 515, 606, 615, 617, 631-2).

The commercial success has been due to use of the cheaper petroleum solvents, and to the flame heaters, neither of which Gessler had in mind (I, 551). These factors are more fully developed under the discussion of infringement on pages 19-24 of this brief.

The record shows that commercial success has been fundamentally the result of Cray's conception of using heating devices, plus the development of new flame heaters and the selection by others than Gessler of a cheap solvent, with a lower vapor pressure at 150° C. than that specified by Gessler. Gessler's patent is for ink alone.

As to "long felt want", the record is barren of any evidence that prior to the time Cray went to Gessler with the request for a heat-set ink, any chemist or maker of printing ink had tried and failed to compound such an ink. Prior patents (pp. 12-15, *supra*) disclose that heat-set inks had been occasionally made for purposes there stated. One witness made the bald assertion that there had been a "demand" for twenty

years for a way of drying ink after printing on rotary presses (I, 627). Obviously, he meant that during all that period it would have helped printers if they had had heating devices and heat set inks. He said he himself had first begun to think "along those lines" when Life magazine first came out (1937, I, 629). If there was a "demand" or need in connection with fast rotary presses, the record does not show that anyone had given voice to it prior to 1931, and there is no evidence that anyone had tried and failed to compound a suitable heat-set ink. Cray said that one of his customers pressed him about it in 1931 (I, 73). He then supplied the "key" by his proposal to attach heaters to the presses, and then put to Gessler his request for the ink, which was forthcoming at once (I, 708-9).

The record definitely establishes that the failure of magazine printers to adopt a method for using fast rotary presses with heat set inks, was *not* due to any difficulty in compounding a heat-set ink. The record only suggests the real reasons for delay. Up to fifteen years ago, the circulation of the publications may not have been large enough to justify the expense for machinery. Printers have heavy investments in presses. It cost one printer $100,000 to supply one old press with a heating device (I, 571). Since the low cost petroleum inks and flame heaters were developed, one printer has spent $500,000 for three presses for only one magazine (I, 153). The delay may have been the result of mere inertia.

Infringement.

The claim requires that substantially all of the liquid component of the ink shall have a vapor pressure as low as that of butyl carbitol (.02 mm.) at ordinary temperature (20° C.). The "502-C oil" solvent in the accused ink has that characteristic. The claim also requires that the major portion of the liquid component shall have a vapor pressure "which at 150° C. approximates" 40 mm. Petitioner's ink solvent, at 150° C. has a vapor pressure of only 20 mm. (I, 50, 56, 240, 281, 306; II, 741). 40 mm. is the vapor pressure of ethyl alcohol at ordinary temperature (II, 733a, col. 1, l. 73; col. 2, l. 2). 20 mm. is about the vapor pressure of water at ordinary temperature (I, 317-8; III, Ex. A).

The question of infringement turns on whether a vapor pressure of 20 mm. "approximates" one of 40 mm. There is much in the record which discloses the conditions and the knowledge of the patentee in the light of which the claim was drawn and is to be interpreted. Why the patentee chose approximately 40 mm. as his standard is obvious. None of the claims he had drawn prior to September 28, 1935, contained any specification of vapor pressure on application of heat. His original claim 7 was for a solvent

> "characterized by a rapid rise in its vapor pressure curve at elevated temperatures" (II, 779).

Claims added as late as January, 1935, stated:

> "a vapor pressure at elevated temperatures sufficiently high to cause rapid evaporation of the solvent" (II, 835).

It was not until September 28, 1935 (II, 873-7), that claims then added contained the statement describing the solvent as one having a vapor pressure which "at 150° C. approximates that of ethyl alcohol at ordinary temperatures" (40 mm.).

Gessler's first selection was the solvent butyl carbitol with a vapor pressure of 60 mm. at 150° C. That is the only solvent he had in mind until 1934 (I, 707, 720; II, 733a, col. 1, l. 71). But by spring of 1934 his butyl carbitol ink was found to damage printing rollers made of glue-glycerine (I, 91-2, 121-4; II, 766-67b).

Gessler went to the Mellon Institute at Pittsburgh to get a solvent that would not damage the rollers, and was told about new solvents the Institute had worked out, one of which was butyl carbitol acetate (I, 134). *That has a vapor pressure at 150° C. of 40 mm.* (I, 125-6; II, 767a, col. 1, ll. 64-75).

He then, on March 17, 1934, applied for and there was issued to him August 30, 1938, another patent with one claim which specified butyl carbitol *acetate* as the solvent (II, 767).

On September 28, 1935, forced by the Patent Office to be specific, Gessler cancelled his earlier claims for the patent in suit and substituted others, in which he adopted the 40 mm. at 150° C. vapor pressure of the acetate as his standard (II, 873-77). In his specification for the acetate patent, speaking of the acetate, he said (II, 767a, col. 1, l. 73):

> "its vapor pressure at 150° C. approximates the vapor pressure of ethyl alcohol at ordinary temperatures (about 40.0 mm. of mercury)."

Thus, comparing the acetate, which has a vapor pressure at 150° C. of about 40 mm., with alcohol, which has a vapor pressure of 40 mm. at ordinary temperature, he states that the one "approximates" the other, showing that he meant by "approximates" that they were about the same.

That is how he decided on the 40 mm. standard.

The record also justifies the conclusion that when he finally used the term "approximates" 40 mm., he knew of no type of heater to safely apply a heat which would instantly dry a solvent with a vapor pressure at 150° C. as low as 20 mm. Cray had suggested only the drum or roller heated by steam (I, 73-4, 97, 708-9). That was used with the butyl carbitol inks (I, 81, 132, 190, 198, 213).

From then on Gessler thought in terms of steam heated drums or rollers (II, 763, l. 19; I, 722). The flame heater for fast rotary presses, now used for the low vapor pressure petroleum inks, was not developed until 1936 or 1937 (I, 551). This statement was challenged in the respondent's brief in opposition to certiorari (p. 13), citing the Brunell patent of 1926 (II, 1000), for a method of using a gas burner to dry, or rather crystalize the ink after printing, just enough to remove the static electricity which caused the paper to cling to the rollers (II, 1000, ll. 100-5; 1002, ll. 63-5). The ink stayed wet for hours (I, 563, 571, 162).

But, there is no indication that Gessler had ever heard of Brunell, or of a flame heater when he drew his claims, or until the flame heater was developed by others so as to use the cheaper low vapor pressure petroleum solvents (I, 551). Conde Nast Press put in presses with flame heaters in 1937 (I, 152, 154, 156). The W. F. Hall Printing Company added their flame

heaters in 1937 (I, 551, 564). R. R. Donnelly & Sons Company put in presses with flame heaters in 1936 (I, 586, 601-6) to use with Levey petroleum inks. Regensteiner Company began in 1939 to use flame heaters for petroleum inks (I, 623, 632). Crowell-Collier Publishing Co. was using presses with flame heaters in 1937 (I, 237, 507). They used, among others, the Levey petroleum inks (I, 237, 504-6).

With the heated drum, the paper is in contact with a segment of the drum surface for as much as two feet (I, 74, 215). Slowing down or stopping the press enlarges the time of contact (I, 79, 192, 722-3). If the drum is very hot, the paper would be damaged when the press slows or stops (I, 206). Super-heated steam at 245° F. (136° C.) can be used in a drum if the paper moves fast enough and the outside of the drum is not that hot (I, 205-6). In the flame type heater, there is a gas burner and the inked side of the paper passes at high speed within about an inch from the tips of the gas flames (I, 93, 550, 617). The instant the press slows, the flame is *automatically* moved away from the paper to a safe distance (I, 92-4). Intense heat can thus be used. One witness said:

> "Those heaters will take most anything out of an ink" (I, 553).

The flame heaters were described as:

> "blasting the sheet with heat" (I, 615).

The temperatures near the tips of the gas flame run from 1500° F. to 1900° F. (815° to 1040° C.) (I, 68, 92, 550-1, 606). The record does not show any measurement of the heat at the paper surface, but with 1700° F. one inch away, it must be high. One

witness estimated it as high as 275° F. (I, 70); another as high as 400° F. (I, 550). The highest temperature Gessler mentions in his patent is 150° C. He there speaks of solvents "highly volatile" at 150° C. (II, 733a, col. 1, ll. 71-75; col. 2, l. 16). In the file wrapper, Gessler's attorneys, in 1935, stated (II, 790):

> "The temperature of the printed material when it passes, for instance, over a heated roller, lies between 100° C. and 150° C., and it is evident that practically instantaneous evaporation of the ink (solvent) takes place . . ."

Again (II, 840) in the file wrapper, in discussing McElroy's patent, Gessler's attorney stated that a temperature of 500° F. (260° C.)

> "is much higher than that which could be used in the successful operation of applicant's process."

At page 890 in the file wrapper Gessler's attorney stated:

> "To accomplish the results obtained by applicant's ink, no solvent can be equivalent to this solvent (butyl carbitol), if it has a vapor pressure substantially higher than 0.06 mm. at 20° C., for in this case the ink would dry on the press, or if it has a comparatively low vapor pressure at 150° C., as in this case it could not be vaporized instantly by any heat which can safely be applied to printing matter."

These references show that when Gessler said "approximates" 40 mm., in 1935, he did not know that any solvent with a lower vapor pressure was practicable.

In his testimony, conscious of the weakness of his claim of infringement, he said that his invention included any solvent whose vapor pressure at 150° C.

is "on the order of centimeters" as distinguished from millimeters, and added:

> "Well the order of centimeters runs from one centimeter on up, does it not?" (I, 126).

His claim does not say "one centimeter"; it says approximately 40 mm. (four centimeters). His early claims were as broad as he now contends the allowed claims to be, and covered any solvent with a high enough vapor pressure on application of heat to quickly dry. *Those claims he abandoned* (II, 817-20, 875).

In the argument (pp. 34, 35) we deny his right to recapture the abandoned claims by stretching those he substituted.

The record also justifies the conclusion that in stating the vapor pressure at 150° C., he meant that the vapor pressure of the solvent should be as high as that, and that it was immaterial if it were higher than 40 mm. at 150° C., as long as it was below .02 mm. at ordinary temperature. In claims he submitted in April, 1936, he clearly indicated that (II, 912-915). In a claim, then numbered 56, he said (II, 914):

> "*a sufficiently high* vapor pressure at 100° C. to permit rapid drying" by application of heat (Italics ours.)

Specification of Errors.

The Circuit Court of Appeals erred:

1. In holding that Gessler made an invention and that his ink resulted from anything more than the application of ordinary skill in the art.

2. In holding that the petitioner had infringed and in construing the statement in the claims that the solvent must have a vapor pressure at 150° C. which "approximates" 40 mm., to include one having a vapor pressure of only 20 mm. at 150° C., and thus failing to apply Section 4888 R. S., which requires that the invention be clearly and exactly defined.

3. In setting aside the findings of the District Court, despite the established rule that such findings shall not be set aside unless "clearly erroneous".

Summary of Argument.

I. The patent is void for want of invention. Gessler did nothing which required more than ordinary skill in the art. He did not suggest the use of heaters. That was proposed to him by Cray. He did not invent or discover a solvent with the required characteristics. Such solvents had been made by others, and were on the market, and their characteristics were disclosed in trade catalogues.

Asked if he could compound an ink which would stay moist at room temperature and dry instantly on application of heat, Gessler's answer was immediate. It was obvious to one of very ordinary skill that for the liquid portion of the ink a solvent having such characteristics should be used. Deciding "how to select" the solvent was not invention. Furthermore, prior patents plainly taught the use of such solvents to make "heat-set" inks.

II. There was no infringement. The claims are not broad enough to cover petitioner's ink. The

claims includes only inks with a solvent having a vapor pressure at 150° C. which "approximates" 40 millimeters. At that temperature petitioner's ink solvent has a vapor pressure of only 20 mm. The record plainly shows that Gessler did not know that a solvent with so low a vapor pressure could be used. To construe the claims to mean that 20 mm. "approximates" 40 mm. is to disregard R. S. Sec. 4888, which requires the claims to clearly state the limits of the invention.

III. The findings of the District Court were not "clearly erroneous". On the contrary, they were supported by the clear weight of evidence. They should not have been overturned by the Court below.

ARGUMENT.

I.

The patent is void for want of invention. It discloses only the application of ordinary skill in the art.

This Court has steadfastly adhered to the rule that to be valid, a patent must be supported by the exercise of invention and not merely the skill of the calling. *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 90, 91; *Altoona Publix Theatres Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 486; *Atlantic Works* v. *Brady*, 107 U. S. 192, 200; *Hotchkiss* v. *Greenwood*, 11 How. 264, 267.

This case is controlled by the rule expressed in the cases cited.

It has been said:

> "Our inquiry, therefore, must be addressed to the question of whether the combination is novel

> and whether it passes the line sometimes tenuous and difficult of ascertainment which separates mechanical skill from invention." *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, 180.

Here the question is not a difficult one. The answer is found in the patentee's own testimony.

It must be borne in mind that the use of fast rotary presses to print on non-absorbent paper, printing both sides and folding, in one operation without delay, requires two elements, *i. e.*, a heating device on the press, and an ink which stays wet on the inking rollers and type, but dries instantly on application of heat.

This patent is only for the ink, not for the method, and the question is whether the composition of such an ink required of a chemist more than the ordinary skill in his art. Gessler did not suggest the heater. Cray did that. Nor did Gessler invent or discover a solvent with the required characteristics. He found one advertised in the catalogue of a chemical manufacturer, with the necessary characteristics there disclosed. Later, when he wanted another solvent, he went to the Mellon Institute for it. This narrows him down to his own statement that it was invention to *discover how to select* the solvent ingredient.

Given the statement by Cray that a heater could be used on the press, and asked for an ink which would not dry on the type but would dry instantly on being heated, did it require invention or only ordinary skill for Gessler to reach the conclusion that the major liquid component, the solvent, should not dry at room temperature, but should dry instantly when heated? Gessler's testimony answers that question.

When asked by Cray whether such an ink could be supplied, he instantly answered in the affirmative. We

think of an invention as at least requiring some reflection. Gessler needed none. Between 1930, when Gessler had compounded his odorless ink containing butyl carbitol, such reflection as he had given to the matter of producing an ink which would stay moist on the type and dry on the print had been directed to producing an ink whose inherent qualities, without change in temperature, would cause it to act in that way. That he could not do. When the temperature change by use of a heater was suggested, that, as he said, was the "key" to the problem. The production of a heat-set ink was simple. He knew instantly of a suitable solvent. He had used it for his odorless ink. Any competent chemist would have known, or ought to have known, that the liquid component of such an ink must be one which will not evaporate at room temperature, but will evaporate when heated, and then have proceeded to select such a solvent from among known substances. He would not even have needed the teachings of prior patents and publications, which do teach that such an ink can be made by selection of the characteristic solvent.

The prior patents and publications are described at pages 12-15 of this brief. They show "heat-set" inks and the choice of certain solvents to produce them. In one, the Doughty patent, the solvent had a vapor pressure as low as .02 mm. at ordinary temperatures, and 60 mm. at 150° C., precisely like Gessler's butyl carbitol (I, 307-8, 321; II, 961, 1099; III, Exs. E-1, D-1). Doughty's patent was laid aside by the Court below mainly because he applied heat to the type instead of to the print. Lefferts disclosed heat drying inks, using oil of cassia as a solvent, which has vapor pressure as low as .02 mm. at ordinary temperature, and 40 mm. at 150° C. (I, 282, 321-2; II,

957; III. Exs. P, Q). This patent was laid aside by the Circuit Court of Appeals for alleged failure of the petitioner to prove that oil of cassia in 1888 was the same as the oil of cassia of 1942, although one witness said it is the natural essence of a plant and is accepted as being the same (I, 332, 336). The finding of the District Court on this point should have been taken as conclusive.

Neither the alleged satisfaction of a "long-felt want" nor commercial success of heat-set inks can be used to support respondent's claim to invention. Satisfaction of a "long-felt want" is important only if there is a recognized need which became articulate and for a time remained unsolved.

As the Court said in *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U. S. 350, 356:

> "As evidence in its favor on the question of invention, plaintiff cites efforts to find something useful to protect open-flame torches from extinguishment by wind or rain put forth by one engaged in operation of a street railway and by another employed by a manufacturer of lanterns. But it does not appear that either was familiar with the relevant prior art. Nor is there any evidence of general widespread effort to solve the problem here involved. There is nothing that tends to raise what patentees did to the realm of invention."

In *Paramount Publix Corp.* v. *American Tri-Ergon Corp.*, 294 U. S. 464, 476, it was said:

> "Thus there is no basis shown by this record for the contention that advance in this phase of the motion picture industry was awaiting the de-

velopment of the combined sound and picture record upon a single positive film. On the contrary, the inference seems plain that the advance awaited the public acceptance of the sound motion picture; that when the public demand became manifest it was still necessary to develop suitable mechanisms, not embraced in the patent, for the reproduction of sound from film. There had long been, ready at hand, knowledge in the photographic art which would enable one skilled in the art to produce the film suitable for use in the new apparatus."

In *Altoona Publix Theatres Inc.* v. *American Tri-Ergon Corp., supra*, in holding Vogt's patent invalid, the Court said (294 U. S., at p. 488):

"* * * the record fails to show that there was any long-felt or generally recognized want in the motion picture industry for the device defined by the flywheel claims, or that the use of sound motion pictures was delayed by the inability of those skilled in the art to add a flywheel to the apparatus in order to give the desired uniformity of motion to linear phonograms. * * * When the need arose for a mechanism suitable to move film records with such speed-constancy as to reproduce the sound successfully, it was forthcoming. Only the skill of the art was required to adapt the flywheel device to familiar types of mechanism to secure the desired result."

Here there is no evidence that any chemist ever failed to produce a "heat-set" ink when asked to do so. There is even no evidence that prior to 1931, when Cray acted, any desire or "need" for the use of new fast rotary presses for magazines had become articulate. Any delay in adapting rotary presses to heat-

set inks cannot be laid to the inability of the ordinary ink compounders to compound a heat-set ink. The record shows, on the contrary, that as soon as the need for such inks was expressed, and as soon as the advantages to be gained thereby justified the large expenditures necessary to convert the presses to the use of such ink by adding heating devices, the inks were forthcoming.

In *Firestone Tire & Rubber Co. v. United States Rubber Co.*, 79 F. (2d) 948, 954, the Court said:

> "Many reasons present themselves to explain delay or failure in adopting a method, however obvious, which, though promising a better or more economical result, must still replace a demonstrated method satisfactory to the industry at its then stage of development. We are unable to say when in respect to Dunlop's engaging in automobile tire manufacture cord fabric came into use. If earlier, it may still have appealed to reasonable business judgment to follow general practice. If later, replacing expensive machinery and retooling of the plant might not lightly have been undertaken, unless advantage of change promised to be immediately and highly compensatory, and even then availability of capital and reasonable expectation of the industry's stability or expansion were important things to consider. It may also well be that mass production of automobile tires had not yet reached such proportions as to make a comparatively minor saving in labor cost the important consideration that it later became."

The facts bearing on commercial success and "long felt want" are related on pages 15-18 hereof. The record shows that commercial success was not the result of Gessler's ink but resulted from the use of

heaters, a suggestion of Cray's, and of the development by others of inks with petroleum solvents having a lower vapor pressure at 150° C. than Gessler thought could be used.

In *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 94 (1941), the Court said:

> "The commercially exploited device because of the differences in its structure from that shown by Mead is the more compact and easily operated. Its utility as a lighter to be located on the dash of an automobile, which is said to be the merit of the Mead invention, is obvious. *If the improvements resulting in such utility involved invention, it is not the invention of Mead. If they exhibited only the skill of the art, their success cannot be relied on to establish invention by Mead, who did not show or make them. The case is therefore not one for the application of the doctrine that commercial success or the manifest satisfaction of a felt need will turn the scale in favor of invention.*" (Italics ours.)

II.

Infringement.

In the claims, the solvent is required to have a vapor pressure not over .02 mm. at ordinary temperature, and a vapor pressure at 150° C. which "approximates" 40 mm.

The petitioner's ink has a solvent with a vapor pressure not over .02 mm. at ordinary temperature, but its vapor pressure at 150° C. is only 20 mm.

The question is whether a vapor pressure of 20 mm. approximates 40 mm.

Facts bearing on infringement are given on pages 19-24 hereof.

The respondent advances two arguments, accepted by the Circuit Court of Appeals, which seem plausible at first blush but turn out to be fallacious.

One is that 20 is as close to 40 as is 60; that if we exclude 20, we must also exclude 60, and if that be done we exclude butyl carbitol, which has a vapor pressure of 60 mm. at 150° C., and is a solvent which obviously the patentee intended to be within his stated range.

The other argument is that 20 mm. is so much closer to 40 mm. than it is to .02 mm., that by comparison it can fairly be said to approximate 40 mm.

One fallacy of the first argument is that it erroneously assumes that the patentee, in stating the vapor pressure at 150° C., was giving both a minimum and a maximum. Taking the whole record, it is obvious that the patentee meant that the vapor pressure at 150° C. should be as high as approximately 40 mm. Provided always that the vapor pressure at room temperature is as low as .02 mm., the patentee did not care if the vapor pressure at 150° C. was over 40 mm. (p. 24 hereof).

It is reasonable to ask that the claims be interpreted in the light of the facts known to the patentee when he drew them.

Claims of the scope of those in suit were filed in the Patent Office in September, 1935 (II, 873-7). Originally, butyl carbitol, having a 60 mm. vapor pressure at 150° C., was in Gessler's mind. Later he found the acetate to be preferable for use on glue-glycerine rollers, and its vapor pressure at 150° C. is 40 mm. (I, 124-6). So when required to be specific, he named the lower vapor as his standard. His inter-

est was also to state as low a vapor pressure at 150° C. as would operate, so as to capture all solvents which might thereafter become available.

He did not in 1935 know that solvents with a vapor pressure at 150° C. as low as 20 mm. could be used. Their successful use requires the heat of a flame heater, which he then knew nothing of, and which was later developed to be used with low vapor pressure petroleum solvents.

The drum type heater could not safely be used at the high temperatures required for petroleum solvents (pp. 21-22 hereof).

Furthermore, his declarations in the files of the Patent Office (p. 23 hereof) show he did not think a heat as high as that of the flame heater could be used.

In short, if 20 be now said to approximate 40, it is giving to the claims a scope and meaning which the patentee himself did not intend them to have when he wrote them. The record plainly shows that if Gessler's claims have captured inks with solvents as non-volatile at 150° C. as water is at ordinary temperature (20° C.) Gessler has found himself the possessor of a monopoly with a scope far beyond his conception when he drafted his claims.

Gessler, in his testimony, stated that his invention covers any solvent whose vapor pressure at 150° C. "is on the order of centimeters" which he states is from one centimeter up. He wants approximately 40 mm. to be stretched to include 10 mm. The difficulty is that his claim does not state that it includes solvents with a 10 or a 20 mm. vapor pressure at 150°. He once had claims broad enough to cover such solvents, but abandoned them, and should not be al-

lowed to recapture them. *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136.

If he did intend to cover such solvents as petitioner's, he was laying a trap for the unwary. The main purpose of Sec. 4888 is to save people from becoming unintentional infringers. *United Carbon Co.* v. *Binney & Smith*, 317 U. S. 228, 236.

The statute requires the invention and its limits to be *clearly* defined.

On this record the claim fails to clearly include the accused ink. On the contrary, a fair interpretation is the other way.

III.

The findings of the District Court were not clearly erroneous.

The established rule is that findings of a trial court may not be set aside on appeal unless "clearly erroneous". That is the modern equity rule.

Silver King Coalition Mines Co. v. *Silver King Consol. Mining Co.*, 204 Fed. 166;
Warren v. *Keep*, 155 U. S. 265;
Furrer v. *Ferris*, 145 U. S. 132;
Tilghman v. *Proctor*, 125 U. S. 136, 149;
Kimberly v. *Arms*, 129 U. S. 512, 524;
Davis v. *Schwartz*, 155 U. S. 631;
Adamson v. *Gilliland*, 242 U. S. 350, 353.

The rule has been written into the Federal Rules of Civil Procedure [Rule 52(a)]. Surely, more than lip service should be paid to this rule.

We think the clear weight of the evidence is against invention and infringement. Surely on this record it may not be said that the trial Court's findings to that effect are "clearly erroneous".

In a recent case (*Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275) on a question of invention, the Court felt impelled to sustain the patent in deference to the concurrent findings of the two lower Courts.

Here, the findings of the District Court and the Circuit Court of Appeals conflict, and the Circuit Court of Appeals should have felt bound to sustain the trial Court's findings, as there is ample evidence to support them. We think the learned Judges of the Circuit Court of Appeals failed to give any real weight to the findings of the District Court, and in passing on the case *de novo*, as they seem to have done, reached conclusions which a careful scrutiny of the record does not support.

Respectfully submitted.

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